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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,156	01/12/2001	Kazuya Otsuji	0445-0293P	8912

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EXAMINER

BALSIS, SHAY L

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 04/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,156

Applicant(s)

OTSUJI ET AL.

Examiner

Shay L Balsis

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 and 8 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is still unclear as to how one knows when they have obtained the proper elastomer since the ~~applicant is just claiming the frictional force test. It is also not clear as to why the applicant is~~ claiming the elastomer based on the frictional force test rather than the structure of the actual elastomer. Additionally it is unclear as to how the invention works. How did the applicant arrive at the range of 9.8-29 N? What are the elastomeric properties that would produce such a range?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Francoeur, Sr. et al. (USPN 5569521).

With respect to claim 1, Francoeur discloses a cleaning pad for removing dry particles from surfaces such as clothing, upholstery and the like. The surface of the cleaning pad comprises a sheet made of an elastomeric material (22). This elastomeric material forms the cleaning surface of the pad. The record is silent as to whether or not the elastomer sheet has a maximum static frictional force within the range of 9.8-29 N. Since it has all the same structural elements of the claimed invention, it is inherent that the elastomers structure disclosed would produce the frictional force test results claimed.

With respect to claim 2, Francoeur discloses a support sheet (28) this is made of “a substantially thin strip of relatively rigid yet bendable and resilient material” (col. 2, lines 61-64).

~~This support sheet is laminated to the elastomeric material using a rubber based glue.~~

With respect to claim 3, Francoeur discloses that the elastomeric material has piles or projections (see fig. 5).

With respect to claim 4, Francoeur discloses that the support sheet is made of a high density polyethylene. High density polyethylene can come in many forms including film.

With respect to claim 5, Francoeur discloses a cushioning material (40) that is adhered to the support (28). The cushioning material is formed of a flexible material that prevents wear. The cushioning material is then folded around the outside the device so that the elastomer was the outside cleaning surface (see fig. 6)

With respect to claim 6, Francoeur discloses a support/cushion sheet (28) this is made of “a substantially thin strip of relatively rigid yet bendable and resilient material” (col. 2, lines 61-64). This support/cushion sheet is laminated to the elastomeric material using a rubber based glue. The device includes a holding member (40) with a depression while the cushion has a

protrusion, which fits into the depression (see fig. 6). The elastomer (22) is attached to the cushion so that the elastomer forms the cleaning surface for the device.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara (GB2200380A).

With respect to claim 1, Kuwabara discloses a device for removing fibrous pill from fabric surfaces. The device comprises an elastomeric material (8) disposed on the device to clean the surfaces. The record is silent as to whether or not the elastomer sheet has a maximum static frictional force within the range of 9.8-29 N. Since it has all the same structural elements of the claimed invention, it is inherent that the elastomers structure disclosed would produce the frictional force test results claimed.

With respect to claim 3, Kuwabara discloses that the elastomeric material has projections and depressions located on the surface of the thereof (see fig. 4). The elastic arms (9) represent the projections while the depressions fall in between the projections.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francoeur, Sr. et al. (USPN 5569521).

Francoeur discloses all the essential elements of the claimed invention as recited above, however, the fails to mention what exact elastomer is used for the cleaning pad. Since various types of elastomers are known in the art, it would have been obvious to one skilled in the art at the time the invention was made to use the elastomer or combination of elastomers that best corresponded to the functions and structures of the device as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

Applicant's Arguments

9. Applicant states that:

"None of the cited references discloses the claimed friction property of the elastomer sheet."

"It is readily apparent from a comparison between the inventive examples and the comparative examples in the specification as filed, that all elastomers do not always satisfy the claimed range of the frictional property."

"Since the maximum static frictional force as defined in the claim is not disclosed in any of the cited references, the reference fails to disclose subject matter within the scope of claim 1."

Additionally, applicant states the Francoeur, Kuwabara and Amos references do not teach the claimed static frictional force.

Response to Arguments

10. Applicant's arguments, paper number 7, page 8 under section labeled Unexpected Results, filed 4/4/03, with respect to claim 1 have been fully considered and are persuasive. The rejection of claim 1 with respect to prior art Amos et al. (USPN 3754991) has been withdrawn.

11. The Francoeur and Kuwabara references are silent as to whether or not the elastomeric sheet has a maximum static frictional force that falls within the range of 9.8-29 N. But since both references claim the same structure it would be inherent that if tested the references would have a maximum static frictional force within that range. The burden of proof is shifted to the applicant to provide evidence that the prior art's elastomer does not fall within the claimed range.

as done with the withdrawn Amos reference in the Declaration under 37 CFR 1.132.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

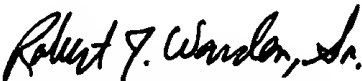
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. ~~Any inquiry concerning this communication or earlier communications~~ from the examiner should be directed to Shay L Balsis whose telephone number is 703-305-7275. The examiner can normally be reached on 7:30-5:00 M-Th, alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

slb
April 18, 2003


ROBERT J. WARDEN, SR.
SUPERVISORY PATENT EXAMINER
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